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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,565	05/31/2001	Takeshi Yamane	010694	7576

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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 10/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/867,565	Applicant(s) YAMANE, TAKESHI	
	Examiner Katarzyna Wyrozebski Lee	Art Unit 1714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment to the advisory.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-6.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Katarzyna Wyrozebski Lee
Primary Examiner
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Attachment to the Advisory

In view of the after final amendment filed on 10/2/2003, the rejections of record are not overcome.

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by GARDZIELLA (US 4,918,116).

The discussion of the disclosure of the prior art of GARDZIELLA from paragraph 2 of the office action mailed on 2/5/2003 is incorporated here by reference.

The substitute specification submitted on October 2, 2003 is hereby entered. The substituted specification does not incorporate new matter issues, merely renumbers pages per objection raised in the first office action.

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The prior art disclosure JP 07-116303 discussed on page 4 of the applicants response has not been submitted. The PAJ website that examiner has accessed again still gives the disclosure for "Electrically Driven Prize Winning Device"

The amendment to the claim 1 of the present invention overcomes the 112 rejection applied against present claims in the final office action mailed on 7/2/2003.

In the after final response to the rejection dated 7/2/2003 the applicants have argued following:

a)

Applicants submit that this disclosure means that 80 °C is the temperature of the mixture at the time of addition of the hexamethylenetetramine. That is, the mixture has already been cooling somewhat from the original temperature of 100 °C of the novolac, and has reached 80 °C at the time of addition of the hardener, and that the "another 3 minutes" represents continued cooling.

By contrast, claim 1 recites "wherein the mixing of said raw materials in said mixing step is carried out by stirring and mixing the raw materials under heating in a dry system at a temperature where said binder is softened" (emphasis added). That is, heating involves raising the temperature of the raw materials until the binder is softened. This may be seen, for example, on page 11, lines 1 to 5 of the substitute specification, which read: "weighed, mixed using Eirich for 5 minutes and then kneaded in a kneader under heating at 110 °C for 5 minutes in Examples 1 to 5."

With respect to the above statement, examples 5-9 of the prior art of GARDZIELLA disclose the following:

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EXAMPLE 9

9500 g of a mixture of dolomite of different grain size were heated to 80° C. in a mixing unit and then 500 g of the novolac of Example 4 pre-heated to 80° C. with a molar ratio of 1:0.35 was homogeneously distributed in the mixture followed by 10% Hexamine with respect to the resin mixed in. After mixing, the mixture was pressed either directly at 80° C. or was permitted to cool to obtain a free flowing material readily pressable due to the extremely strong viscosity increase of the resin.

There is nothing in the prior art of GARDZIELLA teaching cooling step. Example 11 of the prior art of GARDZIELLA discloses temperature of 100°C at which mixing can be completed.

EXAMPLE 11

1 kg of a novolac of Example 3 was heated to approximately 100° C. and was added to a mixture heated to 100° C. consisting of a 3 kg of steel wool, 1.5 kg of brass shavings, 1 kg of coke, 0.5 kg of graphite, 0.5 kg of polyaramide fibers (2 mm), 1.5 kg of barium sulfate, and 0.7 kg of magnesium oxide as well as 0.2 kg of aluminum oxide. The mixture was mixed intensively in a high-power mixer for approximately 5 minutes and 0.2 kg of 50% aqueous hexamethylenetetramine at 80° C. was added. Mixing was continued for another 3 minutes

There is also no mention of cooling step, but the hexamine was at a temperature of 80°C when it was added to the composition for curing. Although the applicant feels that the composition has been cooled, if the prior art of GARDZIELLA does not say so, then it probably did not cool the mixture. The two examples pasted into the office action do not show cooling.

For the sake of the argument, even if the prior art of GARDZIELLA did teach cooling step, the present claims for one do not exclude such step, and second, they do not discuss any temperature ranges. If, for the sake of argument, the prior art of GARZIELLA cooled the composition to 80°C, this temperature is still a softening temperature of the phenolic resins, it is still being heated and it hexamethylene would not cure the composition. As long as the binder is

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softened and other components added while it is softened, the prior art of GARDZIELLA meets the claims.

b)

That is, Gardziella differs from the present invention in that, in Gardziella, the hardener is only added during cooling, not during heating.

As the examiner stated above, there is nothing in the examples of the prior art of GARDZIELLA that says that the composition is cooled.

c)

Applicants also submit that in Gardziella, since the hardener is added and mixed under cooling at a temperature lower than 80 °C, the binder does not get softened while the hardener is present. Claim 3 requires that the binder is softened with the hardener present in the mixture.

The examiner requests that the applicants take a look at the two examples pasted into this office action. The two temperatures are those of 80°C and 100°C. Hexamethylene is definitely present and the binder is definitely softened.

During the interview conducted on 9/22/2003 the same issues were discussed as in the above response and examiner indicated that claims as presented are not in condition for allowance. The applicants have to distinguish the present invention by incorporating into the process claims something that the prior art of GARDZIELLA does not teach and through filing an RCE, since incorporating any new subject matter at this point would be considered new issue


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and consideration. If there are any questions, the applicants are more than welcome to contact the examiner of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (703) 306-5875. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Katarzyna Wyrozebski Lee
Primary Examiner
Art Unit 1714

October 13, 2003